

### **REMARKS**

Entry of the foregoing, reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 15-19 and 21-45 were pending. By the present response, claim 25 has been amended. Thus, upon entry of the present response, claims 15-19 and 21-45 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: page 10, lines 31-35.

Entry of the foregoing is appropriate pursuant to 37 C.F.R. §1.116 for at least the following reasons. First, the amendments raise no new issues that would necessitate further search and/or substantive reexamination. Second, the amendments clearly overcome the grounds of rejection. Third, the amendments place the application in better form for appeal.

### ***CLAIM REJECTIONS UNDER 35 U.S.C. §103***

Claims 15-45 stand rejected under 35 U.S.C. §103(a) as being unpatentable over WO 01/93803 A2 to Chevallier et al. (using U.S. Patent No. 7,033,576 B2 as an English translation) (hereafter "Chevallier et al.") on the grounds set forth on page 2 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

Initially, it is noted that claim 20 is rejected on the above noted grounds. However, claim 20 has been canceled.

The present invention is directed to precipitated silica characterized by low water uptake, and a process for preparation of the same. Conventional precipitated silica generally exhibit a high affinity for water molecules due to the presence of Si-OH groups on the surface thereof. According to the present invention, a precipitated silica is provided possessing a unique combination of properties, including a low water uptake, which render it especially suitable for certain applications.

A precipitated silica formulated according to the principles of the present invention as set forth in claim 15. Claim 15 recites:

*15. A precipitated silica comprising:  
a CTAB specific surface of 140 to 230 m<sup>2</sup>/g,  
a DOP oil uptake of greater than 300 ml/100 g,  
a water uptake of less than 6%,  
a pH of 3.5 to 7.5,  
a level of residual anion, expressed as sodium sulfate, of less  
than or equal to 2%, and  
a mean particle size or a median particle diameter of less than  
30 μm.*

Chevallier et al., which is commonly owned by the assignee of the present application, neither anticipates nor renders obvious the precipitated silica of claim 15.

Chevallier et al. is directed to precipitated silica useful as a thickening or texturing agent. As admitted on page 11 of the Official Action, Chevallier et al. fails to disclose a precipitated silica having the claimed low water uptake properties required by claim 15. Nevertheless, it is asserted that it would have been "obvious to one of ordinary skill in the art at the time of the invention to have expected the silica of Chevallier et al. to have a water uptake similar to that of the instant invention . . . ." This assertion is respectfully traversed.

The grounds for rejection appear to confuse, or improperly combine, the two distinct concepts of inherency and obviousness. A determination of obviousness

cannot be supported upon a finding of inherency alone. This is because that which is inherent is not necessarily known. Obviousness cannot be predicated upon that which is unknown. *In re Spormann*, 150 USPQ 449, 452 (C.C.P.A. 1966).

Moreover, It is improper to rely upon inherency has some form of substitute for a teaching or suggestion supporting an assertion of obviousness. *In re Newell*, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989) ("[A] retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claim combination").

When assertions are made based upon features that are not expressly disclosed in the prior art, the Federal Circuit has repeatedly stated that in order to establish the inherency of the missing element it must be shown that the missing element must necessarily be present in the reference, and would be recognized as such by those persons of ordinary skill in the art. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991; *In re Oelrich*, 666 F.2d 578,581, 212 USPQ 323, 326 (C.C.P.A. 1981) ("inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient"); *Standard Oil Co. v. Montedison, S.p.A.*, 664 F.2d 356, 372, 212 USPQ 327, 341 (3d Cir. 1981) (for a claim to be inherent in the prior art it "is not sufficient that a person following the disclosure sometimes obtain the result set forth in the [claim]; it must invariably happen").

The structure implied by process steps should be considered when assessing patentability where the manufacturing process steps would be expected to impart

distinctive structural characteristics to the final product. *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979).

Chevallier et al. is commonly owned by the assignee of the present application. Moreover, the present application shares two inventors in common with Chevallier et al. Thus, Applicants are well-aware of the silica disclosed in Chevallier et al., its properties and the methods for making it. In fact, Chevallier is specifically addressed on page 2 of the present specification:

Highly structured precipitated silicas exhibiting a DOP oil uptake of greater than 250 ml/100 g, in particular of the order of 300 to 320 ml/100 g, and a CTAB specific surface (external surface) of 70 to 250 m<sup>2</sup>/g have already been provided as thickening or texturing agent in dentifrice compositions (application WO 01/93803); **such silicas exhibit a water uptake of greater than 7%,** that is to say conventional for precipitated silicas. (emphasis added)

Therefore, regardless of whether it would have been "obvious to have expected the silica of Chevallier et al to have a water uptake similar to that of the instant invention," **in reality it does not.** The grounds for rejection clearly fail to make out a *prima facie* case of inherency (or obviousness), given the evidence cited above which is part of the disclosure of the present application.

In addition, contrary to the assertion contained in the Official Action, the precipitated silicas of the present invention are prepared by a distinct process. For example, the process for producing the precipitated silica of the present invention utilizes and produces a filter cake having a higher admission loss at 1000°C than that described by Chevallier et al. Given the well-recognized correlation between the method of preparing a precipitated silica, and its resulting morphological properties, it would not be expected that the precipitated silica of Chevallier et al. would inherently possess the low water uptake characteristic of the presently claimed invention.

Thus, reconsideration and withdrawal of the rejection is respectfully requested.

The remaining claims depend from claim 15. Thus, these claims are also distinguishable over Chevallier et al. for at least the same reasons noted above.

Moreover, as mentioned above, Chevallier et al. also fails to disclose, or even suggest, the process recited by claim 25, including a filter cake which, as a result of the process exhibits, prior to the drying of it in stage (f), a loss on ignition at 1000°C of greater than 82%. Claim 25 has been amended to remove any doubt that this claimed feature is not optional.

#### **CONCLUSION**

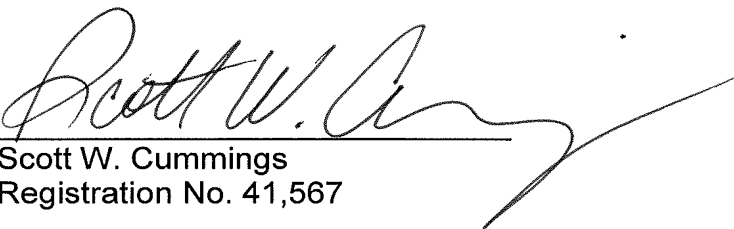
From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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